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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,501	12/19/2001	Joseph S. Wycech	M 6385A	9344
423	7590	10/01/2004	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/026,501	<b>Applicant(s)</b> WYCECH, JOSEPH S. <span style="float: right;">S.C.</span>	
	<b>Examiner</b> Hai Vo	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 22-24, 28-41 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 30-36 is/are allowed.
- 6) ☒ Claim(s) 19, 22-24, 28, 29, 37-41 and 44-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The claim objections are withdrawn in view of the present amendment.
2. The double patenting rejections are withdrawn in view of the terminal disclaimer filed on 08/03/04 which disclaims the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,372,334. The terminal disclaimer has been reviewed and is accepted. The terminal disclaimer has been recorded.
3. The 102 art rejections over Mueller et al (US 5,215,796) are maintained.
4. The art rejections over Nomura et al (US 4,128,683) are maintained.
5. Claims 1-18, and 30-36 are allowed.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 19, 22-24, 28, and 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the holes made through the foamed layer before foaming takes place is not found in Applicant's specification.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 37-41, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al (US 5,215,796) substantially as set forth in the 05/04/2004 Office Action. With newly added claims 50 and 51, figure 2 reads on the claim limitations. The art rejections have been maintained for the following reasons. Applicant argues that Mueller's bathtub is not a smooth continuous contour. The examiner disagrees. Each of figures 1-6 of Muller does show the laminate having an outer layer of a curved continuous contour, which reads on the presently claimed subject matter. The examiner interprets that the smooth continuous contour is intended to be no discontinuation within the outer layer of the laminate. Accordingly the art rejections are thus sustained.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 19, 22-24, 28, 29 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al (US 4,128,683) substantially as set forth in the 05/04/2004 Office Action. Claim 29 should be included in the art rejections over

Normura in the Office Action mailed on 05/04/2004. Normura does not specifically disclose the sound absorbing panel being used in combination with an automobile door. However, It is believed that once the prior art renders obvious the use of the sound absorbing panel as an auto ceiling panel, the use of the sound absorbing panel in combination with a particular component of the vehicle; i.e, vehicle door is not a patentable advance but involves only routine skill in the art to attenuate the interior noise in the vehicle. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the sound absorbing absorption panel in combination with the vehicle door motivated by the desire to attenuate the interior noise in the vehicle.

With regard to newly added claims 47-49, the auto ceiling panel comprises a vinyl chloride sheet 4, and a first polyethylene foam 2 wherein each of the holes in the foam layer 2 is aligned with a hole in the vinyl chloride sheet 4 (figure 1). Normura discloses each of the passageways created by the pattern of holes in the foam layer 2 and the vinyl chloride sheet 4 has a straight continuous longitudinal axis and has a uniform diameter through its length.

The art rejections have been maintained for the following reasons. Applicant argue that the holes created through the foamed layer before foaming distinguishes over Normura since Normura forms the holes through the foam layer after the foaming takes place. Although Applicant and Normura use the two different approaches to form the holes through the foam layer, (Applicant forms

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the holes before foaming while Normura creates the holes after foaming), the products resulting from the two different processes are structurally the same. The auto ceiling panel of Normura comprises a vinyl chloride sheet 4 and a first polyethylene foam 2. The first polyethylene foam and the vinyl chloride sheet are provided with a plurality of small holes through two layers. Accordingly, the examiner maintains that there is no structural distinction between the products of the Normura invention and the present invention. Applicant argues that the creation of the holes after foaming would not enable the holes sufficiently to function to control paint read-through that would otherwise result by the creation of cure shrinkage strains. Applicant states that Normura is not concerned with providing paint read-through, but rather is concerned with acoustical problems in an auto ceiling panel. It is reminded that "the paint read through control structure" is related to the functional language. The product claims must be structurally distinguishable from the prior art. While features of a product may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function. **In re Schreiber**, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Further, it appears that the auto ceiling panel of Nomura comprises a plurality of holes as described in Applicant's specification. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. Therefore, it is not seen that the auto ceiling panel of Nomura would have performed differently than the claimed

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reinforcement laminate in terms of paint read-through control structure. This is in line with *Ex parte Tummers et al.* 137 USPQ 444 which holds that if the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art.

12. Neither Mueller nor Normura discloses a laminate comprising a structure as recited in claims 1-18, and 30-36. The composite material of Mueller is suitable as a bathtub, therefore, it would not have been obvious to make plurality of holes completely through the composite material because to do so would destroy it for the intended utility. The auto ceiling panel of Normura comprises the two foam layers 2 and 3 which are made of a polyethylene foam. There is no teaching or suggestion in the Normura invention that one of the foam layers is rigid and another compliant as required by the claims.

### **Conclusion**

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

  
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